

The opinion in support of the decision being entered today
is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CAITLYN CURTIN

Appeal No. 2007-3253
Application 10/733,414
Technology Center 3700

Decided: September 27, 2007

Before CHARLES F. WARREN, THOMAS A. WALTZ, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicant appeals to the Board from the decision of the Primary Examiner finally rejecting claims 1 through 14 in the Office Action mailed June 20, 2005. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2005).

We reverse the decision of the Primary Examiner.

Claim 1 illustrates Appellant's invention of a dryer, and is representative of the claims on appeal:

1. A dryer comprising:

A diffuser for allowing air to exit in order to dry a surface of a user's body;

movement means for moving the diffuser over a wide range of angles in order to dry different parts of the surface; and

control means for sending instructions to the movement means in order to control the movement of the movement means over the wide range of angles.

The Examiner relies on the evidence in these references:

Jones	US 5,822,878	Oct. 20, 1998
Chan	US 5,857,263	Jan. 12, 1999
Bahman	US 5,970,622	Oct. 26, 1999
Aisenberg	US 6,038,786	Mar. 21, 2000

Appellant requests review of the following grounds of rejection advanced on appeal (Br. 7):

claims 1 through 3, 5, 6, 8, 13, and 14 under 35 U.S.C. § 102(b) as anticipated by Jones (Answer 3);

claim 4 under 35 U.S.C. § 103(a) as unpatentable over Jones in view of Aisenberg (*Id.* 5);

claims 7, 9, and 10 under 35 U.S.C. § 103(a) as unpatentable over Jones (*Id.*);

claim 11 under 35 U.S.C. § 103(a) as unpatentable over Jones in view of Bahman (*Id.* 6); and

claim 12 under 35 U.S.C. § 103(a) as unpatentable over Jones in view of Chan (*Id.*).

Appellant argues the claims in the first and third grounds of rejection as a group (Br. 8-9 and 10-11). Thus, we decide this appeal based on claims 1, 2, 4, 8, 9, 11, and 12 as representative of the grounds of rejection and Appellants' groupings of claims. 37 C.F.R. § 41.37(c)(1)(vii) (2005).

The issues in this appeal are whether the Examiner has carried the burden of establishing a prima facie case in the grounds of rejection advanced on appeal.

The claimed dryer encompassed by claim 1 is specified as comprising at least “movement means” for the stated function and “control means” for the stated function. Claim 2 further limits claim 1 in specifying “securing means” for the stated function. Claim 8, on which claim 9 depends, further limits claim 1 in specifying “muffler means” for the stated function. None of the stated functions specifies structure to perform the function.

The Examiner states:

The control means has not been construed to invoke the sixth paragraph of 35 USC 112 since the means for language is used, which is further modified by functional language, but is not considered to be modified by sufficient structure, material or acts for achieving the specific function (since control means . . . for sending is interpreted as a sufficient act for achieving a control function.

Answer 4. The Examiner also considers the “movement means” in terms of function. *Id.* 3. Further, the Examiner has not considered the “securing means” of claim 2, the “muffler means” of claim 7 which is not limited in structure by claim 8, or the affect of further limitations on “means” recitations in other claims.

We determine the Examiner has improperly considered the “means” limitations in the claims with respect to the strictures of 35 U.S.C. § 112, sixth paragraph, since the “corresponding structure” in the Specification and “equivalents” thereof with respect to the means limitations have not been determined in a manner consistent with the requirements of this statutory provision before applying the references to the claims.

The resolution of the issues with respect to the rejections of appealed claims under 35 U.S.C. §§ 102(b) and 103(a) advanced on appeal requires that the “means” language in the claims must first be interpreted by giving the claim terms their broadest reasonable interpretation consistent with the written description provided in Appellant’s Specification as it would be interpreted by one of ordinary skill in this art. *See In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (“[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.”); *In re Donaldson Co.*, 16 F.3d 1189, 1192-95, 29 USPQ2d 1845, 1848-50 (Fed. Cir. 1994) (*en banc*) (“[T]he ‘broadest reasonable interpretation’ that an examiner may give means-plus-function language is that statutorily mandated in [35 U.S.C. § 112,] paragraph six.”); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant’s invention and its relation to the prior art.”) (citing *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)).

In view of the “means” recitations, the claims must be interpreted with respect to whether any or all of the “means” limitations specify a

function without defining structure sufficient to satisfy that function. If any or all of the “means” limitations specify only a function and not the structure for satisfying that function, the strictures of 35 U. S. C. § 112, sixth paragraph, apply to the limitation(s). *See Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1208, 64 USPQ2d 1812, 1822-23 (Fed. Cir 2002), and cases cited therein. Claims containing “means” language complying with this statutory provision must be construed as limited to the “corresponding structure” disclosed in the written description in the Specification and “equivalents” thereof. *Donaldson*, 16 F.3d at 1192-95, 29 USPQ2d at 1848-50.

The “corresponding structure” is that “structure in the written description necessary to perform that function [citation omitted],” that is, “‘the specification . . . clearly links or associates that structure to the function recited in the claims.’ [Citation omitted.]” *Texas Digital Systems*, 308 F.3d at 1208, 64 USPQ2d at 1822-23. “[A] section 112, paragraph 6 ‘equivalent[]’ . . . [must] (1) perform the identical function and (2) be otherwise insubstantially different with respect to structure. [Citations omitted.]” *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1364, 54 USPQ2d 1308, 1315-16 (Fed. Cir. 2000). “[T]wo structures may be ‘equivalent’ for purposes of section 112, paragraph 6 if they perform the identical function, in substantially the same way, with substantially the same result. [Citations omitted.]” *Kemco Sales*, 208 F.3d at 1364, 54 USPQ2d at 1315. “[T]he ‘broadest reasonable interpretation’ that an examiner may give means-plus-function language is that statutorily mandated in [35 U.S.C. § 112,] paragraph six,” and in this respect, the examiner should not confuse “impermissibly imputing limitations from the specification into

a claim with properly referring to the specification to determine the meaning of a particular word or phrase recited in a claim. [Citations omitted.]”
Donaldson, 16 F.3d at 1194-95, 29 USPQ2d at 1850; *see also Morris*, 127 F.3d at 1055-56, 44 USPQ2d at 1028 (explaining *Donaldson*).

Here, the “means” limitations in claims 1, 2, and 8 recite function but not structure sufficient to carry out the function and thus, comply with 35 U.S.C. § 112, sixth paragraph. These limitations have not been considered with respect to the corresponding structure and equivalents thereof in the Specification as required by 35 U.S.C. § 112, sixth paragraph. Thus, the Examiner did not first interpret the “means” claim language in the claims before applying the prior art and, therefore, did not consider all of the claim limitations in making out the grounds of rejection. *See, e.g., In re Geerdes*, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791-92 (CCPA 1974) (in considering grounds of rejection “every limitation in the claim must be given effect rather than considering one in isolation from the others”); *cf. Donaldson*, 16 F.3d at 1195-97, 29 USPQ2d at 1850-52.

Accordingly, in the absence of consideration of all of the claim limitations, the Examiner has not established a prima facie case of anticipation and of obviousness.

Therefore, we reverse the grounds of rejection advanced on appeal.

The Primary Examiner’s decision is reversed.

Remand

We remand the application to the Examiner for consideration and explanation of the issues raised by the record. 37 C.F.R. § 41.50(a)(1) (2007); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 5, August 2006).

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Upon further examination of the appealed claims subsequent to the disposition of Appeal, the Examiner is to consider the “means” imitations in the appealed claims with respect to the requirements of 35 U.S.C. § 112, sixth paragraph, in considering the patentability of the claims over the prior art.

We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

REVERSED AND REMANDED

clj

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